

## REMARKS

Claims 1-10, 13-21, 23-27, 29-33, 35-38, 40, 41, 50-65, 67, 68 and 129 were pending and presented for examination and in this application. In an Office Action dated September 15, 2009, claims 1-10, 13-21, 23-27, 29-33, 35-38, 40, 41, 50-65, 67, 68 and 129 were rejected. Based on the above Amendment and the following Remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections, and withdraw them.

### Omnibus Rejection

In the after-final Amendment dated July 27, 2009 (“AFA” herein), Applicants argued that the rejection of claims 1-7, 9, 10, 13, 15-21, 23-27, 29-33, 35, 37, 38, 40, 41, 50-65, 67, 68 and 129 was an improper omnibus rejection. See AFA, p. 17; citing MPEP 707.07(d) (“A plurality of claims should never be grouped together in a common rejection, unless that rejection is **equally applicable** to all claims in the group.” (emphasis added)).

The Advisory Action dated September 15, 2009 (“AA” herein) alleges that this assertion is “untimely” because prior actions have included this rejection, and this argument was never raised before. The AA also notes that the BPAI affirmed this rejection during appeal.

Applicants first note that, as acknowledged by the AA, Applicants did not raise this issue in the appeal. Thus, the BPAI did not issue a decision on this issue. Moreover, Applicants are not aware of any rule that precludes or estops them from raising this issue now simply because it was not raised previously, and assert that the rejection is in fact improper, per the MPEP section cited above. If this “untimely” allegation persists to be raised in defense of the rejection, Applicants request citation of a statutory basis or MPEP

section indicating that an improper rejection can be maintained on the basis that Applicants' argument was not raised previously.

**Response to Rejection under 35 U.S.C. § 103(a)**

In the Office Action, claims 1-10, 13-21, 23-27, 29-33, 35-38, 40, 41, 50-65, 67, 68 and 129 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hartman et al., U.S. Patent No. 5,960,411 in view of Yamada, U.S. Patent No. 6,336,100. These rejections now are traversed.

**A. The Cited References Do Not Disclose or Suggest an Element for Enabling Display of Order Fulfillment Instructions for Ordering the Identified Item**

In the AFA, Applicants argued that neither Hartman nor Yamada, alone or in combination, disclose or suggest "providing for display at the client system an element for enabling order fulfillment instructions for ordering the identified item." *See AFA*, p. 18-20.

The AA responds (referring now to a different section of Hartman) that "Hartman ... displays an indication of an action (e.g., a single action such as clicking a mouse button) that a purchaser is to perform to *order the identified item*. In response to the indicated action being performed, the client system *sends to a server system the provided identifier and a request to order the identified item*." AA, p. 2 (also citing BPAI decision mailed 1/26/2009 ("BPAI decision" herein), p. 6, ll. 11-20 "confirming the same.") (emphasis added).

Applicants first note that the above statements about Hartman, correctly articulated in the *Findings of Fact* section of the BPAI decision, are not in dispute. However, as articulated by the Examiner above, the indication of Hartman causes the item *to be ordered*; it does not describe the ability to "**enabl[e] display of order fulfillment options**" as presently claimed.

Yamada does not remedy this deficiency of Hartman for the reasons articulated in the AFA.

**B. The Cited References Do Not Disclose or Suggest Providing for Display A Plurality of Order Fulfillment Options, Each Comprising Delivery Address, Shipping Instructions, and Payment Source**

In the AFA, Applicants argued that references do not disclose or suggest “providing for display at the client system a plurality of order fulfillment options predefined for a user of the client system, each order fulfillment option comprising a unique combination of a delivery address, shipping instructions, and a payment source.” *See AFA, p. 20-21.*

The AA responds by articulating an argument similar to that in the Final Office Action, without addressing the arguments contra raised by Applicants in the AFA.

Specifically, reference is made to FIG. 1C (item 108) of Hartman. As indicated at the top of FIG. 1C (and accompanying text at col. 5, ll. 40-43), FIG. 1C displays *a summary of combined orders*. FIG. 1C thus addresses the combining of orders that *previously* have been placed; section 108 does not provide an “option,” but *mere information* pertaining to the previously-placed orders.

It is unclear to Applicants how the FOA makes the logical jump from the *mere information* provided by Hartman to using that information as *an order fulfillment option* when combined with Yamada. Indeed, to so modify Hartman would impermissibly change Hartman’s principle of operation. *See In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); MPEP 2143.01 V. The purpose of the information shown in FIG. 1C is the combining of placed orders for delivery to a common address. Thus, to allow that information to become an “option” such that it is modifiable would not only be a non-

obvious combination/modification, it would also be undesirable, and would in fact defeat the purpose of the *order combining*, which is the context of FIG. 1C.

The AA also recites the standard that the test is “what the combined teachings of those references would have suggested to those of ordinary skill in the art.” AA, p. 2. Based on the above, the combined teachings would not suggest what the AA proffers.

**C. The Cited References Do Not Disclose or Suggest Sending a Request to Order the Identified Item in Response to Receiving Selection of One of the Plurality of Fulfillment Options**

In the AFA, Applicants argued that the references do not disclose or suggest “in response to receiving, subsequent to the first indication, a second indication of selection of one of the plurality of order fulfillment options as a single action to order the identified item, sending to a server computer a request to order the identified item....”

The AA relies on the arguments noted in sections A. and B. above, but does not directly address the issue raised by the AFA, which is that neither Hartman nor Yamada show sending the order request **in response to selection of an order fulfillment option**. This element is separate from, and in addition to, those discussed above.

As articulated in the AFA, Hartman shows ordering an item using a single action, e.g., clicking the Buy item button 103a, but does not disclose selection of a fulfillment option as the single action. Yamada shows selection of a “station,” but such selection, even assuming *arguendo* that it could be considered a fulfillment option, **is not what triggers the order placement** in Yamada. Rather, following such selection, the user must check the statement, enter a password, and click the order button. *See* Yamada, FIG. 2, steps 7-10, FIGS. 9-11 (showing the three different screens for these actions), and col. 4, l. 66 – col. 5, l. 3.

In fact, the suggested combination of references actually teaches away from the claimed invention, because it suggests that you *either* predefine single-action settings such that sensitive information does not need to be transmitted to complete the order (*see, e.g.,* Hartman, 2:12-16; 3:66-4:3), or you can chose from multiple addresses for shipping, but you cannot do so through a single-action ordering process because you first need to confirm the order and your identity (*see, e.g.,* Yamada, 4:66-5:3). The AA did not address this argument.

Even combined, the references would need to be modified in a non-obvious way. For example, Hartman would need to be modified to change the single-ordering action step to a mere item selection step, which would need to be followed by an order fulfillment selection step. Applicants note that this modification entails more than merely reversing the order of the selection of fulfillment information and item selection/order placement of Hartman. The standard for obviousness is not “[t]he mere fact that [the] references *can be* [] modified,” as doing so “does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art.” *See KSR International Co. v. Teleflex Inc.*, 550 U.S. 398 (2007); MPEP 2143.01 (III).

Hartman provides a single-action ordering mechanism specific to a user with pre-defined 1-click settings. However, to change the 1-click settings (e.g., via button 103c of FIG. 1A), e.g., to modify the ship to, shipping address, or payment information, requires the user to login to the system via a separate webpage. *See, e.g.,* Hartman, col. 4, ll. 49-54. Thus, the suggested modification would require a complete reworking of how the ship to, shipping address, or payment information is modified in Hartman, and a webpage redesign for the 1-click ordering screen (e.g., FIG. 1A). The suggested combination thus would take the cited aspects of Hartman and/or Yamada well beyond their “established functions,”

precluding the “predictability” of such combining. The discussion above indicates that the claimed invention is “more than a predictable use of [these] prior art elements according to their established functions.” *See KSR*. The AA also failed to rebut this argument.

Finally, Applicants note that the additional arguments presented for independent claims 10, 29, 31-33, and 56, the cited references have additional deficiencies, as articulated on p. 23-25 of the AFA (as well as several dependent claims as discussed in the AFA). These arguments also were left unaddressed by the AA.

Applicants request that all arguments presented herein, as well as those presented in the AFA, be addressed in future office communications.

### **Conclusion**

In sum, Applicants respectfully submit that claims 1-10, 13-21, 23-27, 29-33, 35-38, 40, 41, 50-65, 67, 68 and 129 as presented herein, are patentably distinguishable over the cited references. Therefore, Applicants request reconsideration of the basis for the rejections to these claims and request allowance of them.

In addition, Applicants respectfully invite the Examiner to contact Applicants’ representative at the number provided below if the Examiner believes it will help expedite furtherance of this application.

Respectfully Submitted,

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